

REMARKS

Claims 1-9 stand rejected under 35 U.S.C. § 102 as being anticipated by Jih '548 ("Jih"). Claims 1 and 8 are independent. This rejection is respectfully traversed for the following reasons.

In order to expedite prosecution, Applicant's representative initiated an interview with Examiner Bataille. Applicant and Applicant's representative would like to thank Examiner Bataille for his courtesy in conducting the interview and for his assistance in resolving issues. As a result of the interview, it was agreed that Jih does not disclose the present invention as recited in the pending claims so that the Examiner would withdraw the pending rejection. The Examiner indicated that he would need to update the prior art search before allowing the application. A summary of the interview which includes remarks directed at distinguishing independent claims 1 and 8 over Jih follow.

Claim 1 recites in pertinent part, "an address translation unit for receiving an instruction address ... and for translating *the instruction address* into a substitutive address ..., said address translation unit outputting the substitutive address to said instruction storage unit *instead of the instruction address*" (emphasis added). Claim 8 recites a similar feature in method claim format. The Examiner relies on the special instruction detecting circuit 30 of Jih as the claimed address translation unit. However, it is respectfully submitted that the special instruction detecting circuit 30 does not translate the *received instruction address* into a substitutive address. Instead, when the received instruction address from the ROM matches with a page selecting code 22 from the RAM, the special instruction detecting circuit 30 outputs a substitutive address *in the next cycle* to the program counter (*see* col. 4, lines 35-36) *while continuing processing of the instruction address*. Accordingly, the "instruction address" of Jih

is NOT translated into a substitutive address but is instead decoded and executed (*see Figure 7 in relation to the instruction address 110*). It follows that the special instruction unit 30 does NOT output the substitutive address to said instruction storage unit *instead of the instruction address* but rather the special instruction unit outputs the substitutive address *in addition* to the instruction address.

In contrast, in one exemplary embodiment of the present invention as shown in Figure 4 of Applicants' drawings, the instruction address from the program counter 10 is received by the address translation unit 20 and *either* the instruction address or the substitutive address is sent to the instruction storage unit 30. Accordingly, the present invention can have the capability to process the substitutive address *in a given cycle* based on the comparison between the instruction address and modifying address, whereas in Jih the instruction at the substitutive address is necessarily processed in the next cycle after the instruction address has been read (*see Figure 7*).

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Jih does not anticipate claims 1 and 8, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1 and 8 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also

patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is submitted that claims 1-9 are patentable over Jih. Accordingly, it is respectfully requested that the rejection of claims 1-9 under 35 U.S.C. § 102 be withdrawn.

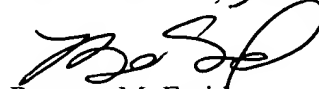
CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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